

### **DETAILED ACTION**

This communication is in response to the Request for continued examination (RCE) filed on 08/28/2008.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114.

Applicant's submission has been considered and has been entered.

#### ***Information Disclosure Statement***

Receipt is acknowledged of Information Disclosure Statement (IDS), filed on 08/28/2008 and also on 10/16/2008 which has been entered in the file.

#### ***Status of Claims***

Claims 1-9 are currently pending in the application.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed

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invention. The claims contain the subject matter of a newly introduced proviso compound such as, “with the proviso that the compound is not methyl-4-[[[(7-methyl-1H-benzimidazol-1-yl)acetyl]amino]benzoate” [claim 1 (currently amended), lines 20-21, page 2 and all other occurrences] to exclude the prior art compound. These subject matters are considered new matters since the specification and the originally filed claims excluded these subject matters from the compounds as can be seen by original claims 1-9, and in the specification on pages 6-10 and 16-18. The amendment changes the scope of the claims to include the proviso compound that was not previously included in the invention. This rejection can be overcome by deleting the new matter from the instant claims and also amend the claims within the context and scope of the claims (limiting with specific type of compounds that actually contemplated in the specification) in order to overcome the rejection.

### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Golem Shamed, Ph.D. whose telephone number is (571) 272-0706. The examiner can normally be reached on Tuesday-Friday from 8:30 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (571) 272-0699. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone number for this Group is 571-273-8300.

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documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mcKane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (571) 272-1600.

/Golam M. M. Shameem, Ph.D./

Primary Examiner

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